UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,330	10/22/2003	Istvan Boldogh	265.00390101	1384

26813 7590 04/18/2005

MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581415
MINNEAPOLIS, MN 55458

EXAMINER	
KAM, CHIH MIN	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/691,330	BOLDOGH ET AL.	
	Examiner	Art Unit	
	Chih-Min Kam	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *16-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/11/04;3/4/04;* 5/25/04; 11/1/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-15 and SEQ ID NO:8 in the response filed March 8, 2005 is acknowledged. The traversal is on the ground(s) that the claimed inventions can be readily evaluated in one search without placing undue burden on the Examiner. The argument is not found persuasive because the traversal is not on the grounds that the inventions are not independent and distinct, rather, the traversal is on the grounds that there is no burden of search. As such restriction is proper if two or more claimed inventions are either independent **or** distinct. See MPEP 803. Furthermore, coexamination of each of the additional groups and sequences would require search of subjects and sequences unnecessary for the examination of the elected claims. For example, if Groups II and III were included, it would require additional search of β-amyloid and retinoic acid; and if sequences other than SEQ ID NO:8 were included, it would require additional sequence search. Therefore, coexamination of each of these inventions would require a serious additional burden of search.

The restriction groups have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the invention is not coextensive particularly with regard to the literature search. A reference which would anticipate the invention of one group would not necessarily anticipate or make obvious any of the other group. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exist.

Upon reconsideration, SEQ ID NOs:1-7 are included in Group I, thus claims 1-15 and SEQ ID NOs:1-8 are examined.

The requirement is still deemed proper and is therefore made FINAL.

Informalities

The disclosure is objected to because of the following informalities:

2. In the declaration, the instant application claims the benefit of a PCT Application No. PCT/US03/33423 under 35 U.S.C. 120, however, the specification does not indicate whether the instant application is a continuation, divisional or CIP of the PCT application in the continuation data at page 1, lines 11-13 of the specification. Appropriate clarification is required.

3. At page 12, line 18, the text contains a web site identified by a URL, which is not permissible in the patent application and requires deletion.

Claim Objections

4. Claims 6 and 7 are objected to because the claim contains recitation of non-elected sequences (SEQ ID NOs: 9-34).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of inhibiting apoptosis or reducing DNA damage in a cell, the method comprising contacting the cell with an effective amount of colostrinin, a constituent peptide of colostrinin with a defined sequence (e.g., SEQ ID NOs:1-8),

or a combination thereof, does not reasonably provide enablement for a method of inhibiting apoptosis or protecting against DNA damage in a cell, the method comprising contacting the cell with an effective amount of colostrinin, a constituent peptide thereof, an active analog thereof, and combinations thereof, where the structure of the constituent peptide or the active analog is not defined, and the components of the combinations are not identified. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claims 1-5 and 7-15 encompass a method of inhibiting apoptosis or protecting against DNA damage in a cell, the method comprising contacting the cell with an effective amount of colostrinin, a constituent peptide thereof, an active analog thereof, and combinations thereof. The specification, however, only discloses cursory conclusions (page 3, lines 8-27), which state that the present invention provides a method of inhibiting apoptosis or protecting against DNA damage in a cell comprising contacting the cell with colostrinin, a constituent peptide, an active analog or combinations thereof, where the active analog is an active analog of a constitute peptide of colostrinin selected from the group of SEQ ID NO:1-34, and the active analog comprises a peptide having an amino acid sequence with at least about 15% praline and having at least 70 % structural similarity to one or more constituent peptides of clolostrinin. There are no indicia that the present application enables the full scope in view of the use of colostrinin, a constituent peptide thereof, an active analog thereof, and combinations thereof in the claimed method as discussed in the stated rejection. The factors considered in determining whether undue experimentation is required, are summarized in In re Wands (858 F2d at 731,737, 8 USPQ2d at 1400,1404 (Fed. Cir.1988)). The factors most relevant to this rejection are the

breadth of the claims, the absence or presence of working examples, the state of the prior art and relative skill of those in the art, the predictability or unpredictability of the art, the nature of the art, the amount of direction or guidance presented, and the amount of experimentation necessary.

(1). The breadth of the claims:

The breadth of the claims is broad and encompasses unspecified variants regarding the constituent peptides of colostrinin, and the active analogs thereof, which are not adequately described or demonstrated in the specification.

(2). The presence of absence of working examples:

The specification has shown inhibition of 4HNE (4-hydroxy-2-nonenal)-induced or UV-irradiation-induced apoptosis by colostrinin in PC12 cells (Examples 7-8; Figs 8-9), however, there are no working examples indicating the apoptosis-inhibiting activity or the activity of protecting against DNA damage by active analogs of colostrinin or its constituent peptides.

(3). The state of the prior art and relative skill of those in the art:

The related art indicates colostrinin and its fragment are useful for treating disorders of central nervous system, neurological disorders and neurodegenerative disorders and a composition comprising colostrinin or its constituent peptide is prepared (page 1, lines 25-33 of the instant application; WO 98/14473), and considerable evidence has indicated increased oxidative stress may play a role in the pathogenesis of neuron degeneration and death in the neurodegenerative disorders (Markesbery, Free Radical Biology & medicine 23, 134-147 (1997)). However, the general knowledge and level of the skill in the art do not supplement the omitted description, the specification needs to provide specific guidance on the structures of various constituent peptides and active analogs thereof to be considered enabling for variants.

(4). Predictability or unpredictability of the art:

The claims encompass a method of inhibiting apoptosis or protecting against DNA damage in a cell, the method comprising contacting the cell with an effective amount of colostrinin, a constituent peptide thereof, an active analog thereof, and combinations thereof. However, the specification has not provided sufficient teaching on identifying the active analogs for various constituent peptides of colostrinin, it is unpredictable regarding the effects of these compounds in inhibiting apoptosis or protecting against DNA damage in a cell.

(5). The amount of direction or guidance presented and the quantity of experimentation necessary:

The claims are directed to a method of inhibiting apoptosis or protecting against DNA damage in a cell, the method comprising contacting the cell with an effective amount of colostrinin, a constituent peptide thereof, an active analog thereof, and combinations thereof. The specification shows inhibition of 4HNE-induced or UV-irradiation-induced apoptosis by colostrinin in PC12 cells (Examples 7-8; Figs 8-9), and indicates the active analogs of constitute polypeptides (SEQ ID NOs: 1-34) of colostrinin include polypeptides having at least a portion of colostrinin and its constituent peptides, wherein the portion contains deletions, or additions of one or more contiguous or non-contiguous amino acids, preferably such analogs have amino acid sequences with at least 15% percent proline or have at least 70% structural similarity to colostrinin or one or more of its constituent peptides (page 11, lines 1-16). However, the specification has not demonstrated the activity of inhibiting apoptosis or protecting against DNA damage by various constituent peptides and their analogs as encompassed by the claims. Since the specification does not provide sufficient teachings on the identities of various analogs and the

inhibitory or protecting effects of various constituent peptides and their analogs, it is necessary to have additional guidance and to carry out further experimentation to identify the active constituent peptides and their analogs and to assess the effects of compounds.

(6). Nature of the Invention

The scope of the claims includes many structural variants of constituent peptides of colostrinin and active analogs thereof, but the specification does not provide sufficient teachings on the identities and effects of these peptides in the claimed method. Thus, the disclosure is not enabling for the reasons discussed above.

In summary, the scope of the claim is broad, while the working example does not demonstrate the variants associated with the claimed methods, and the teachings in the specification are limited, therefore, it is necessary to have additional guidance and to carry out further experimentation to assess the effects of various constituent peptides of colostrinin and active analogs thereof in the claimed methods.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15 are indefinite because of the use of the term "combinations thereof". The term cited renders the claim indefinite, it is not clear what components and how much of each component are included in the combination since the identities of the constituent peptides of

clostrinin and their active analogs are not indicated in the claim. Claims 2-6, 8-11 and 13-15 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

7. Claims 1-15 are indefinite because the claim lacks an essential step in the method of inhibiting apoptosis or protecting against DNA damage in a cell. The missing step is the outcome of the treatment, it is not clear what endpoint an effective amount of apoptosis inhibitor would produce? Claims 2-6, 8-11 and 13-15 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

Conclusion

8. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CHIH-MIN KAM
PATENT EXAMINER

***

April 14, 2005